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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
915-005.074

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on 11/17/2008

Signature Kelly Puglio

Typed or printed name Kelly Puglio

Application Number	Filed
10/688,273	October 17, 2003

First Named Inventor
Kimmo Mylly

Art Unit	Examiner
2181	Lee, Chun Kuan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 56,885.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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November 17, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

Attorney Docket No.: 915-005.074

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	Kimmo Mylly
Application No.:	10/688,273
Filed:	Oct. 17, 2003
Title:	Method for changing the mode of a card, a system, a card, and a device
Group Art Unit:	2181
Examiner:	Lee, Chun Kuan

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir,

In response to the final Office Action of August 29, 2008, a Notice of Appeal is filed herewith. Applicant respectfully requests a pre-appeal brief conference for reviewing the pending application.

******If any fee and/or extension is required in addition to any enclosed herewith, please charge Account No. 23-0442.***

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR § 1.8(a))

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Kelly Puglio
Signature

Date: 11/17/2008

Kelly Puglio
(type or print name of person certifying)

REMARKS

Status of the Application

This application includes claims 1, 5-7, 11-13, 15-19, 32 and 38-44. In the Office Action of August 29, 2008, all claims are rejected. With this paper, none of the claims are amended, none are canceled, and none are added. A complete list of the pending claims can be found in a previous response filed on June 30, 2008.

Claim Rejections under 35 USC §103

Claims 1, 7, 11, 13, 15-19, 32 and 43 are rejected under 35 USC §103(a) as being unpatentable over Oh-Yang et al. (U.S. Patent 6,351,820, Oh-Yang hereinafter) in view of Khouli et al. (U.S. Patent 6,308,278, Khouli hereinafter) and Micalizzi, Jr. et al. (U.S. Patent 6,434,820, Micalizzi hereinafter). Claims 5-6, 12, 38-42 and 44 are rejected under 35 USC §103(a) as being unpatentable over Oh-Yang in view of Khouli and Micalizzi, and further in view of Lindskog et al. (U.S. 2002/0132603). In the rejected claims, claims 1, 7, 13, 16, 17, 19 and 32 are independent. All the independent claims are rejected over Oh-Yang/Khouli/Micalizzi.

The primary reference Oh-Yang teaches a PC card 10 that is connectable to a computer interface 80 of a computer system. The card has a normal state and a sleep state. In col. 5, line 66 to col. 6, line 3, Oh-Yang teaches that the computer system may directly give commands to the PC card to change the PC card into the sleep state or to resume the normal state. However, Oh-Yang fails to teach what is recited in claim 1,

transmitting to the terminal an indication of mode change via a data line of the interface so that the device can be used by the terminal immediately, and

wherein the indication of mode change in the device is transmitted in such a manner that a state of the data line is set in a first logical state after the command has been received in the device, and the state of the data line is set in a second logical state after the normal mode is in use in the device (as acknowledged by the Office on page 5, lines 8-13 of the Detailed Action).

Khouli teaches a computer that has a power management device which supplies a normal voltage or a standby voltage to the computer and various peripheral devices connected to the computer. As shown in Fig. 2 of Khouli, when the computer is in the power saving mode (i.e.

the standby voltage is supplied), if an activity is detected in a peripheral device (such as LAN controller 237), a system control interrupt 240 is generated and transmitted to the power management device 214 so that the power supply to the computer and the peripheral device is switched to the normal voltage. On page 5, lines 19-22 of the Detailed Action, the Office asserts that Khouli teaches transmitting to the terminal an indication (e.g. wake signal from LAN controller) indicating the mode change (e.g. between active mode and standby mode) via a data line so that device can be used by the terminal immediately. **This is incorrect**. In fact, the indication (system control interrupt) sent by the LAN controller (or any peripheral device for that matter) is an indication of an activity in that device. It is not an "indication of mode change so that the device can be used by the terminal immediately." Khouli teaches that based on such an indication, the power management device switches the power supply from the standby voltage to the normal voltage, which means the mode change is after such an indication, not before.

Micalizzi's system, as shown in Fig. 1, may be compared with the system of the present invention, also shown in Fig. 1. The system of Micalizzi has a host microprocessor 20 (comparable to the processor 2 in the present application), a host adaptor board 40 (comparable to interface unit 11 of the present application) that comprises a host adaptor (or I/O controller) 50 (comparable to the control unit 14 of the present application), and one or more peripheral devices 80-86 (comparable to the auxiliary device/card 13 of the present application).

Micalizzi teaches that the host microprocessor sends an I/O request to the I/O controller. The I/O request is intended to a peripheral device. The I/O controller processes the request and sends low-level commands associated with the request to the peripheral device. When the request has been completed (i.e. al the commands are sent), the I/O controller notifies the host processor by generating an interrupt (Col. 1, lines 14-41, as cited by the Office, and col. 7, lines 1-10). Micalizzi is different from the present invention in that the interrupt signal is a signal from the I/O controller to the host microprocessor indicating that the request from the microprocessor has been processed by the I/O controller, not a signal from the peripheral device indicating the device is ready for use. Note that in the present application it is clearly described that the auxiliary device or memory card 13 has a control device 17 (see Figure 1) that is responsible for generating an interrupt request when the card is changed to the normal mode, and

the interrupt request is transferred to the terminal 1 via the data line 11a (page 10, lines 29-34). Nowhere in Micalizzi is it mentioned that a signal generated by the peripheral device indicating it is ready to use is sent to the microprocessor via a data line.

Applicant respectfully submits that, the present invention is similar to Oh-Yang in signal transmission between a terminal and an auxiliary device for changing the mode of the auxiliary device. However, the present invention is advantageous over Oh-Yang in that, after the mode change, an indication of the mode change is transmitted from the device to the terminal so that the device can be used by the terminal immediately. The advantages of the present invention over Oh-Yang are described in the present application e.g. on page 3, second paragraph. For instance, normally there is a time delay for a mode change in an auxiliary device, and this time delay may vary from one device to another. Without the terminal being informed of the completion of the mode change, e.g. with a signal indicating the mode change from the device, the terminal has to wait for a predetermined maximum time, in which the terminal believes that the mode of the device have been changed, or the terminal must transmit inquiries to the device at intervals until the device informs that it is in the normal mode. The predetermined maximum time causes unnecessary delays if the device is fast to change the mode, or errors of the device is slow to change the mode. Transmitting inquiries to the device may cause increased load in the terminal and higher power consumption.

The indication of mode change so that the device can be used immediately solves the above problems existing in the prior art such as Oh-Yang. The solution of having the device send an indication to the terminal has a clear advantage over the approaches of the prior art and such a solution is not taught or suggested by Oh-Yang. Therefore, the present invention is clearly distinguishable from Oh-Yang, and, besides, the present invention cannot be achieved by combining Oh-Yang with Khouli and Micalizzi.

Based on the above, Applicant believes that the amended claim 1 does not read on the combination of Oh-Yang, Khouli and Micalizzi. It is respectfully requested the rejection of claim 1 under 35 USC §103(a) be withdrawn. All other independent claims have the features corresponding to that of claim 1. Therefore, these claims are patentable as well. Applicant respectfully requests the above rejections of the claims be withdrawn.

Other Rejections

Claims 1, 5-7, 11-12, 16, 32, 38-39, 41 and 43-44 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant believes the rejection is not proper.

As per claims 1, 7 and 32, they recite "an auxiliary device" in the beginning and refer to it as "the device" in the lines that follow. The Office states that it is not fully clear if "the device" is referring to the previously recited auxiliary device or not. However, referring to the auxiliary device as "the device" is not ambiguous because there is no other "device" mentioned in the claim.

As per claim 16, it recites "a memory card" in the beginning and refers to it as "the card" in the lines that follow. The Office states that it is not fully clear if "the card" is referring to the previously recited memory card or not. However, referring to the memory card as "the card" is not ambiguous because there is no other "card" mentioned in the claim.

Applicant respectfully requests the rejection under 35 USC 112, second paragraph be withdrawn. However, in case the Office does not agree to remove this rejection but the claims are otherwise allowable, the Office is authorized to amend the rejected claims in an Examiner's Amendment.

Conclusion

It is believed that all of the remaining claims in the application are allowable. A decision to withdraw the rejections is respectfully requested.

Respectfully submitted,

11/17/2008
Date

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